

REMARKS/ARGUMENTS

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested.

Applicant and the undersigned wish to thank Examiner Fox for the courtesies extended during the interview of January 24, 2006. The Amendment discussed during the interview has been presented above and the arguments made are repeated herein for the record.

It is noted that claim 21 has been amended above solely to correct an obvious typographical error to avoid any antecedent basis issue. The amendment to claim 21 was not offered in response to any prior art rejection made by the Examiner.

Claims 14-17 were rejected under 35 USC 102(b) as being anticipated by Abels et al. Applicant respectfully traverses this rejection.

The Examiner has characterized Abels as disclosing an upper member that "comprises a planar front portion that protects the side shift operator means" by preventing goods from touching the front face of the support member. Applicant respectfully submits, however, that claim 14 required more than that. Claim 14 specifically required that the planar front portion be positioned between the side shift operator means and the forks, to protect the side shift operator means. Claim 14 has been amended above, as discussed during the interview, to even more specifically recite that the planar front portion of the upper cross member is "directly in front of" the side shift operator means. In the illustrated example embodiment of the invention this feature is shown as portion 32 in Figures 7 and 8 (and shown but not labeled in Figure 4), and described in paragraph [0039], which explains that upper cross member 22 includes a portion 32 that overhangs the frame support member 4 in order to protect the moving parts (such as the pistons 14a, 14b) from being damaged by the load or the forks.

As can be seen from Figure 12 of Abels (which has the reference numbers used by the Examiner), the "upper cross member" does not have any planar front portion positioned between a side shift operator means and the forks to protect the side shift operator means. In other words, there is nothing in front of front face 104a to protect it.

In regard to claim 15, contrary to the Examiner's characterization, the Figure 12 embodiment of Abels does not have convex and concave surfaces as claimed slidably engaged with each other. Rather, Abels provides bearings 110,113.

Claims 21-24 and 3, 5-7 were rejected under 35 USC 103(a) as being unpatentable over Bostad et al. in view of Reeves. Applicant respectfully traverses this rejection.

Claims 21 and 23 each provide *inter alia* that the fork movement assembly includes first and second fork shoes adapted to slide horizontally on said sliding surface (of said lower cross member), that each fork shoe defines a fork contact surface to engage the shank portion of the fork, and that the fork contact surface be located no farther forward than a front face of the upper cross member. The Examiner characterizes Bostad as teaching a side shift assembly including shoe members allegedly as claimed. As agreed during the interview, however, Bostad does not teach fork shoes meeting the above summarized limitations of claims 21 and 23. The secondary reference to Reeves does not teach or suggest fork shoes as claimed either.

Regarding the Examiner's proposed combination of Bostad and Reeves, Bostad discloses a side shifter attachment for a lift truck but does not disclose an automated fork positioner as the forks are positioned manually. Reeves does not teach or suggest a side shift frame. Rather, Reeves teaches forks that are connected directly to a fork lift truck carriage. Thus, Reeves teaches only a fork positioner. The forks are positioned by cylinders 32, 34. According to Reeves' Abstract, for example, the

cylinders permit the forks to be simultaneously positioned at one side or the other side of the center line of the carriage. The Examiner proposes to modify Bostad by incorporating the Reeves fork positioner to allow for automated re-positioning of the forks. It is respectfully submitted, however, that the positioner of Reeves cannot be incorporated in Bostad side shift frame because vertical members 31 preclude the placement of the positioner cylinders Reeves discloses. Therefore, the Reeves fork positioner would presumably have to be mounted in front of the Bostad side shift frame. As noted above, neither Bostad nor Reeves teach or suggest a fork shoe as claimed. But, even if a fork shoe were somehow incorporated in the Reeves/Bostad combination, the Reeves fork positioner would be disposed in front of the Bostad side shifter, any "fork contact surface" of the "fork shoe" would necessarily be located forward of the side shift frame, so that the fork contact surface limitations of applicant's claims 21 and 23 would not be satisfied. On the other hand, even if members 31 could somehow be eliminated without destroying the Bostad assembly, to accommodate cylinders 32, 34, the claimed fork shoes in the combination claimed would still not be taught by the Bostad/Reeves combination.

It is further respectfully noted that if the Reeves fork positioner could somehow be provided in Bostad then the resulting assembly would be unstable. Specifically, the Bostad side shifter permits the shifting of the forks to one side of the lift truck. Further, Reeves discloses that his forks can be positioned to one side as well. Thus, the combination of Bostad and Reeves would allow the shifting of the forks to one side of the center line and the further shifting of the positioned forks to one side of the lift truck by the side shifter. The result would be that the center of gravity of the load carried by the forks may be moved too far to one side of the lift truck, which could cause the lift truck to become unstable and topple over. To avoid this potential problem, in an example embodiment of the invention, the fork positioner includes a centering assembly (recited in dependent claims 11 and 25) which maintains the forks in equal distant relation to the center line of the side shift frame while positioning the

forks. Such a centering assembly is not taught or suggested by Bostad and/or Reeves. In fact, as noted below, it is not disclosed by the tertiary reference to Sorlie cited against claims 11 and 25, either.

For the reasons advanced above, and as agreed during the interview, it is respectfully submitted that claims 21 and 23 are not anticipated by nor obvious from the combination of Bostad and Reeves.

For the reasons advanced above reconsideration and withdrawal of the rejection of claims 21-24 and 3 and 5-7 is requested.

Claim 4 was rejected under 35 USC 103(a) as being unpatentable over Bostad and Reeves and further in view of Bolzoni. Claim 4 is submitted to be patentable over the Bostad/Reeves combination for the reasons advanced above with respect to claims 21 and 23. The Examiner's further reliance on Bolzoni does not overcome the deficiencies of the primary combination noted above. It is therefore respectfully submitted that claim 4 is allowable as well.

Claims 8 and 9 were rejected under 35 USC 103(a) as being unpatentable over Bostad and Reeves as applied to claim 22 and further in view of German Patent No. 20020292. Applicant respectfully traverses this rejection.

Claims 8 and 9 are submitted to be patentable over the Bostad/Reeves by virtue of their dependence on claims 1, 21 and 22. The Examiner's further reliance on German Patent '292 does not overcome the deficiencies of the primary combination. It is therefore respectfully submitted that these claims are allowable as well.

Claim 10 was rejected under 35 USC 103(a) as being unpatentable over Bostad, Reeves, German '292 and further in view of French Patent 7602832. Claim 10 is submitted to be patentable over the Bostad/Reeves combination for the reasons advanced above. The Examiner's further reliance on German '292 and French '832

does not overcome the deficiencies of the primary combination noted above. It is therefore respectfully submitted that claim 10 is allowable as well.

Claims 11 and 25 were rejected under 35 USC 103(a) as being unpatentable over Bostad and Reeves and further in view of Sorlie. Applicant respectfully traverses this rejection.

As noted above, in an example embodiment of the invention a centering assembly is provided and adapted to move the first and second fork shoes so that the fork shoes are maintained at an equal distance from the center of the side shift frame. As noted above, Bostad and Reeves taken alone or in combination do not teach or suggest first and second fork shoes as required by applicant's independent claims 21 and 23. Bostad and Reeves also do not teach or suggest a centering assembly as recited in claims 11 and 25. The tertiary reference to Sorlie does not overcome the deficiencies of Bostad and Reeves in this regard. Indeed, as made clear from the Abstract of Sorlie, the first and second jacks provided by Sorlie are selectively actuatable to independently move the forks and adjust the spacing between the forks. Thus, Sorlie does not teach a centering assembly as required by applicant's claims 11 and 25. It is further respectfully noted that Sorlie, which teaches an assembly having side shiftable and adjustable forks, would clearly be used in the alternative to Bostad (side shifter) and/or Reeves (fork positioner) and the skilled artisan would not attempt a piecemeal combination of isolated components of Sorlie in Bostad and/or Reeves.

Section 103 does not allow the Examiner to engage in picking and choosing from the prior art only to the extent that it will support a holding of obviousness, while excluding parts of the prior art essential to the full appreciation of what the prior art suggests to one of ordinary skill in the art. In re Wesslau, 147 USPQ 391 (CCPA 1975).

Indeed, since Sorlie teaches a combination of side shifting and fork positioning, the skilled artisan without the benefit of applicant's disclosure, would not attempt a

combination of Bostad and Reeves in the first place. They would simply use Sorlie if a combination of side (lifting) and fork positioning was desired.

It is clear that the initial burden of establishing a basis for denying patentability to a claimed invention rests upon the Examiner. In re Piasecki, 745 F. 2d 1468, 223 USPQ 785 (Fed. Cir. 1984). In establishing a *prima facie* case of obviousness under 35 U.S.C. § 103, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to arrive at the claimed invention from the prior art. Ex parte Clapp, 227 USPQ 972 (BPAI 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from applicant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp. 837 F.2d 1044, 7 USPQ 2d 1434 (Fed. Cir. 1988).

Importantly, even if Bostad, Reeves and Sorlie could be combined the centering assembly specifically recited in claims 11 and 25 would still not be taught or suggested. In fact, both Reeves and Sorlie expressly teach against the subject matter of applicant's claims 11 and 25 by specifically providing for independent movement of the forks apparently overlooking the potential for instability recognized by applicant.

In view of the foregoing reconsideration and withdrawal of the rejection of claims 11 and 25 is solicited.

Claims 12, 13 and 26 were rejected under 35 USC 103(a) as being unpatentable over Bostad, Reeves and Sorlie and further in view of Bolzoni. Applicant respectfully traverses this rejection.

As noted above, even if Bostad, Reeves and Sorlie could be combined, the limitations of applicant's claims would still not be anticipated nor obvious. Bolzoni does not overcome the deficiencies of the combined art. It is further respectfully submitted that it would be unobvious in the absence of applicant's disclosure to modify the

Bostad, Reeves, Sorlie combination. In this regard as noted above, both Reeves and Sorlie advocate independent movement of the forks and provide for same. The alleged teaching of Bolzoni is contrary to the teachings of Reeves and Sorlie so that one skilled in the art would not obviously combine the prior art in the manner the Examiner suggests. It is further respectfully submitted that if the teachings of Bolzoni were followed in Bostad, the range of motion of the fork shoes of the resulting combination would be limited on the one hand by the center beam 26 of the Bolzoni fork positioner and on the other hand by the intermediate supports 31 of Bostad. Consequently, even if the Bolzoni fork positioners were incorporated in the examiner's primary combination, the claimed invention would still not be anticipated nor obvious. In this regard, claims 21 and 23 specifically require that the fork positioner move the first fork shoe to and between a center of the side shift frame and one of the side members, which as also claimed connects the longitudinal ends of the upper cross member to the corresponding longitudinal ends of the lower cross member. If the Bolzoni fork positioner were provided in Bostad, the fork positioner assembly would evidently extend between intermediate supports 31. Thus, each fork shoe could not be moved to the center because of the presence of the center beam and could not be moved to the respective side member because the positioner would extend only between supports 31. Thus, the combination proffered by the Examiner would not produce the invention claimed.

It is further respectfully submitted that it would be unobvious to incorporate select characteristics of Bolzoni while ignoring the assembly that he teaches. It would be unobvious to select isolated characteristics of the multiple references the Examiner has cited from Reeves, Sorlie and Bolzoni and selectively incorporate them in Bostad. Indeed, it is respectfully submitted that the only motivation for modifying Bostad so as to produce the invention claimed is the guidance provided by applicant's own disclosure. It is therefore respectfully submitted that the prior art combination advanced by the Examiner is not a combination that would obviously be made by the skilled artisan.

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In view of the foregoing, reconsideration and withdrawal of this rejection is requested.

Claims 18, 19 and 20 were rejected under 35 USC 103(a) as being unpatentable over Abels in view of German '292 and/or French '832. Claims 18 and 20 are submitted to be patentable over Abels by virtue of their dependence from claim 14. The Examiner's further reliance on the German and French patent publications does not overcome the deficiencies of Abels noted above. It is therefore respectfully submitted that these claims should be allowable as well.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance and an early Notice to that effect is earnestly solicited.

Respectfully submitted,

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